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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Attorney Docket No.: 44884.12.1

James Prescott Curry

Customer No. 022859

Application No.: 09/449,237

Examiner: B. Edelman

Filed: November 24, 1999

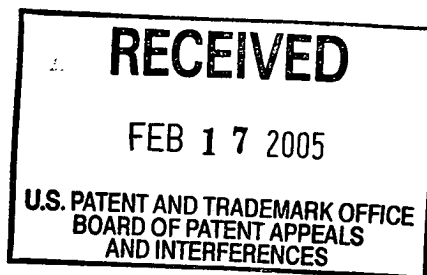
Group Art Unit: 2153

Appeal No.: 2005-0509

For: METHOD AND SYSTEM FOR PROVIDING ON-LINE WELLNESS AND RETAIL
ACCESS THROUGH A DISTRIBUTED NETWORK

PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND THE
"SEPARATE PAPER REQUIREMENT" UNDER 37 C.F.R. § 41.47(b)
IN A REQUEST FOR ORAL HEARING

Mail Stop Petition
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450



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Sir:

A "Notification of Non-Compliance Regarding Oral Hearing" was mailed on January 19, 2005 in the above-identified application. This petition is being timely filed within two weeks of the mailing date of the notification.

Appellant hereby requests suspension of the separate paper requirement of 37 C.F.R. §41.47(b) for requesting an oral hearing, and requests that an oral hearing be scheduled in conjunction with the pending appeal.

37 C.F.R. § 41.47(b) states,

If appellant desires an oral hearing, appellant must file, as a separate paper
captioned "REQUEST FOR ORAL HEARING," a written request for such hearing

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accompanied by the fee set forth in § 41.20(b)(3) within two months from the date of the examiner's answer or supplemental examiner's answer. (Emphasis added).

37 C.F.R. § 41.47(b).

However, at the time of filing the Appeal Brief, 37 C.F.R. § 1.194(b) governed requests for oral hearings. Under former 37 C.F.R. § 1.194(b),

If appellant desires an oral hearing, appellant must file, in a separate paper, a written request for such hearing accompanied by the fee set forth in § 1.17(d) within two months from the date of the examiner's answer. (Emphasis added).

37 C.F.R. § 1.194(b).

As shown above, the rule under former 37 C.F.R. § 1.194(b) differed from the rule under current 37 C.F.R. § 41.47(b) in at least one relevant aspect: § 41.47(b) requires a separate paper captioned 'REQUEST FOR ORAL HEARING'," whereas 37 C.F.R. § 1.194(b) requires only that a written request be made "in a separate paper." As noted by the Board, Appellant's Appeal Brief was submitted with a separate, two-page transmittal letter which referred to the request for oral hearing, in addition to a check that covered the fee for a request for an oral hearing before the Board of Patent Appeals and Interferences. Appellant reasonably believed that the entire filing complied with the rule. The transmittal letter constituted a "separate paper" in compliance with 37 C.F.R. § 1.194(b). It is submitted that the rule change itself is an indication that the earlier "separate paper" requirement was unclear, and that the addition of the more detailed language found in 37 C.F.R. § 41.47(b) was needed to clarify the "separate paper" requirement.

Appellant submits that an extraordinary situation exists and that justice requires the separate paper requirement of 37 C.F.R. § 41.47(b) be suspended or waived in the present


appeal. The rule regarding requests for oral hearings has changed significantly, adding more specific criteria regarding the separate paper requirement. The rule change occurred after the filing of the appeal brief, making it impossible for Appellant to comply, and thereby constituting an extraordinary situation. Justice therefore requires that the separate paper requirement of 37 C.F.R. § 41.47(b) be suspended or waived, since Appellant's request is believed to have been made in substantial compliance with the rule in force at the time, and Appellant believes that a hearing is necessary or desirable for a proper presentation of the appeal.

The petition fee of \$400.00 set forth in 37 C.F.R. § 1.17(f) is submitted herewith for a petition for suspension of rules under 37 C.F.R. § 1.183.

Appellant believes the facts presented above constitute an extraordinary situation, and that justice requires the separate paper requirement of 37 C.F.R. § 41.47(b) be suspended or waived. Appellant respectfully requests that an oral hearing be scheduled in the present appeal.

The Commissioner is authorized to charge to Deposit Account No. 06-1910 for any underpayments, overpayments or additionally required fees.

Respectfully submitted,



Robert Day
Registration No. 54,059

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Please grant any extension of time necessary for entry; charge any fee due to Deposit Account No. 06-1910.

Application No. 09/449,237

CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Attention: Mail Stop Petition, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on:

2/2/05
Date of Deposit

Joyce Thomas
Joyce Thomas

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PETITION FEE

Under 37 CFR 1.17(f), (g) & (h)

TRANSMITTAL

(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450

| | |
|------------------------|----------------------|
| Application Number | 09/449,237 |
| Filing Date | 11/24/1999 |
| First Named Inventor | James Prescott Curry |
| Art Unit | 2153 |
| Examiner Name | Bradley E. Edelman |
| Attorney Docket Number | 44884.12.1 |

Enclosed is a petition filed under 37 CFR 1.183 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 400.00 is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(i), see form PTO/SB/17i.

Payment of Fees (small entity amounts are NOT available for the petition fees)☒ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 06-1910:☐ petition fee under 37 CFR 1.17(f), (g) or (h) ☒ any deficiency of fees and credit of any overpayments

Enclose a duplicative copy of this form for fee processing.

☒ Check in the amount of \$ 400.00 is enclosed.☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.**Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462**

For petitions filed under:

§ 1.53(e) - to accord a filing date.

§ 1.57(a) - to accord a filing date.

§ 1.182 - for decision on a question not specifically provided for.

§ 1.183 - to suspend the rules.

§ 1.378(e) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.

§ 1.741(b) - to accord a filing date to an application under § 1.740 for extension of a patent term.

Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463

For petitions filed under:

§ 1.12 - for access to an assignment record.

§ 1.14 - for access to an application.

§ 1.47 - for filing by other than all the inventors or a person not the inventor.

§ 1.59 - for expungement of information.

§ 1.103(a) - to suspend action in an application.

§ 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.

§ 1.295 - for review of refusal to publish a statutory invention registration.

§ 1.296 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.

§ 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.

§ 1.550(c) - for patent owner requests for extension of time in *ex parte* reexamination proceedings.§ 1.956 - for patent owner requests for extension of time in *inter partes* reexamination proceedings.

§ 5.12 - for expedited handling of a foreign filing license.

§ 5.15 - for changing the scope of a license.

§ 5.25 - for retroactive license.

Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464

For petitions filed under:

§ 1.19(g) - to request documents in a form other than that provided in this part.

§ 1.84 - for accepting color drawings or photographs.

§ 1.91 - for entry of a model or exhibit.

§ 1.102(d) - to make an application special.

§ 1.138(c) - to expressly abandon an application to avoid publication.

§ 1.313 - to withdraw an application from issue.

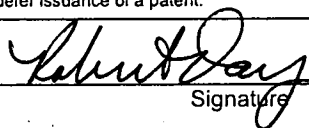
§ 1.314 - to defer issuance of a patent.

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BOARD OF PATENT APPEALS
AND INTERFERENCES


Signature

Robert Day

Typed or printed name

Feb. 1, 2005

Date

54,059

Registration No., if applicable

This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 5 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.